

**REMARKS**

The following remarks are submitted to address the issues raised in the Office Action mailed May 28, 2003. An Office Action was previously mailed on May 21, 2003, but was inadvertently issued as a final Office Action. The Office Action mailed May 28, 2003 withdrew the finality of the May 21<sup>st</sup> Office Action, but relied on the same grounds of rejection. The following remarks address the grounds of rejection set forth in both Office Actions.

Claims 26-43 and 45-46 are currently pending in the application. Please cancel claim 44 without prejudice to its reintroduction in a subsequent application. Claims 26, 28-30, 33, and 43-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 6-70740 in view of Applicant's Admitted Prior Art. Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 6-70740 in view of U.S. Patent No. 1,928,041 to Windesheim (hereinafter "Windesheim"). Claims 31-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 6-70740 in view of U.S. Patent No. 4,886,076 to Gilbert et al. (hereinafter "Gilbert"). Claims 34, 36-38, 41-42, and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 6-70740 in view of Applicant's Admitted Art, as applied in claim 26, further in view of JP 6-46822. Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 6-70740 in view of Applicant's Admitted Prior Art and JP 6-46822 as applied to claim 34, and further in view of Windesheim. Claims 39-40 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-70740 in view of Applicant's Admitted Prior Art and JP 6-46822 as applied to claim 34, and further in view of Gilbert.

Applicant has amended claims 26, 34, 45, and 46. Support for the amendments can be found generally in FIGS. 12, 14-16, and 21, among other places.

Applicant respectfully requests consideration of the application in view of the foregoing amendments and the following remarks.

**Claims 26, 28-30, 33, and 43-45 - 35 U.S.C. § 103(a)**

The rejection of claims 26, 28-30, 33, and 33-45 under 35 U.S.C. § 103(a) as being unpatentable over JP 6-70740 in view of Applicant's Admitted Prior Art is respectfully traversed.

JP 6-70740 relates to a tobacco case capable of directly putting out a cigarette using a fire extinguishing cylinder.<sup>1</sup> The tobacco case of JP 6-70740 includes "a detachable bottom lid" and "[t]he interior of the tobacco housing part 13 is divided so as to enable the insertion of the plural cigarettes 15 before use or the put out cigarettes one by one."<sup>2</sup>

In rejecting the claims, the Examiner also cites excerpts of Applicant's specification as Admitted Prior Art. As to crush proof boxes, the Examiner cites page 1 of the specification, which includes the following excerpt: "One type of popular cigarette package is the so-called 'hard pack,' 'crush proof box' or 'hinged lid package.' Such a package has a generally cuboid-type shape, is manufactured from resilient paperboard, and includes an outer wrap of transparent polypropylene film." Spec., p. 1, ll. 10-13. Regarding the size of crush-proof boxes, the Examiner cites page 10 of the specification, which includes the following excerpt: "Typical crush proof boxes are designed to include about twenty or about twenty-five cigarettes." Spec., p. 10, ll. 14-16. Applicant agrees that these statements are

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<sup>1</sup> See JP 6-70740, English Abstract.

<sup>2</sup> See JP 6-70740, English Constitution.

admissions that (1) one type of cigarette package is a crush proof boxes constructed from resilient paperboard, and that (2) crush proof boxes have been designed to include about twenty or about twenty-five cigarettes. Applicant makes no other admissions regarding these statements from its application.

The present invention advantageously utilizes a paperboard crush proof box designed to hold more than twenty cigarettes. Twenty cigarettes are arranged in the crush proof box (e.g., in a 7-6-7 arrangement with each cigarette in contact with at least one adjacent cigarette as shown in the figures) with the extra space in the crush proof box providing adequate room for the cigarette saver. For example, with a crush-proof box designed to hold twenty-five cigarettes, but actually only including twenty cigarettes, the cigarette saver occupies the space provided for five additional cigarettes. In this regard, the present invention advantageously allows a cigarette manufacturer to sell a normal number of cigarettes in a package that resembles a conventional cigarette package, but also includes a cigarette saver. See Spec., p. 2.

Applicant has amended claim 26 to clarify that a cigarette package comprises a paperboard crush proof box designed to hold twenty-five cigarettes; twenty cigarettes, each cigarette being in contact with at least one adjacent cigarette; and a cigarette saver positioned inside the paperboard crush proof box and comprising two end portions, the distance between the two end portions forming a length of the cigarette saver. The first end portion of the cigarette saver includes an opening to a channel that terminates in the cigarette saver, and the cigarette saver has a cross-sectional area that corresponds to the cross-sectional area of approximately five cigarettes.

Applicant has amended claim 45 to clarify that a cigarette package comprises a paperboard crush proof box designed to hold twenty-five cigarettes; twenty cigarettes, each cigarette being in contact with at least one adjacent cigarette; and a cigarette saver positioned inside the paperboard crush proof box and comprising two end portions, the distance between the two end portions forming a length of the cigarette saver. The first end portion of the cigarette saver includes an opening to a channel that terminates in the cigarette saver, and the cigarette saver occupies a region corresponding to the volume of approximately five cigarettes.

Applicant respectfully submits that JP 6-70740 in view of Applicant's Admitted Prior Art does not teach or suggest a cigarette package having these features.

Because Applicant does not have an English translation of JP 6-70740, the following arguments are based on the English Abstract and Constitution and the Figures. JP 6-70740 fails to teach or suggest a cigarette package that comprises a paperboard crush proof box designed to hold twenty-five cigarettes; twenty cigarettes, each cigarette being in contact with at least one adjacent cigarette; and a cigarette saver comprising two end portions, the distance between the two end portions forming a length of the cigarette saver.

For example, JP 6-70740 does not teach or suggest a paperboard crush proof box designed to hold twenty-five cigarettes as the tobacco case of JP 6-70740 utilizes a housing part 13 for housing plural cigarettes and includes a detachable bottom lid 20. A housing part 13 designed to house twenty cigarettes would appear to require more space than is required to hold twenty cigarettes without a housing part.

In addition, amended claims 26 and 45 specify that each of the twenty cigarettes in Applicant's cigarette packages are in contact with at least one adjacent cigarette. In contrast, none of the cigarettes in JP 6-70740's tobacco case are in contact with adjacent cigarettes due to the housing part. Applicant respectfully submits that a person of ordinary skill in the art would not be motivated to construct the tobacco case of JP 6-70740 without the housing part because the tobacco case is designed to house all the put out cigarette butts in the housing part and because "[t]he interior of the tobacco housing part 13 is divided so as to enable the insertion of the plural cigarettes 15 before use or the put out cigarettes one by one."<sup>3</sup> Due to the difference in lengths between unsmoked cigarettes and cigarette butts, the housing part would appear necessary to facilitate the insertion and removal of cigarettes and cigarette butts. Thus, Applicant also respectfully submits that the Figures and the English Abstract and Constitution of JP 6-70740 also lack any suggest or motivation to not utilize the housing part.

Applicant also submits that the tobacco case of JP 6-70740 would not likely be constructed from paperboard as it would be difficult to construct a paperboard crush proof box with a detachable bottom lid. In particular, Applicant submits that it would be difficult to secure a paperboard bottom lid to a paperboard crush proof box after the bottom lid was detached. Accordingly, Applicant respectfully traverses the combination of JP 6-70740 with Applicant's Admitted Prior Art as a person of ordinary skill in the art would not be motivated to construct the package of JP 6-70470 with paperboard. As noted above, one of the advantages of the present invention is that it allows a cigarette manufacturer to sell a normal

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<sup>3</sup> See JP 6-70740, English Abstract and Constitution.

number of cigarettes in a package that resembles a conventional cigarette package, but also includes a cigarette saver.<sup>4</sup>

For at least the reason that JP 6-70740 does not teach or suggest a cigarette package that comprises a paperboard crush proof box designed to hold twenty-five cigarettes, twenty cigarettes, each cigarette being in contact with at least one adjacent cigarette, and a cigarette saver comprising two end portions and a channel as claimed in claims 26 and 45, Applicant respectfully submits that claims 26 and 45 are patentable over JP 6-70740 in view of Applicant's Admitted Prior Art. As claims 28-30, 33, and 43 depend from claim 26, Applicant likewise respectfully submits that these claims are also patentable. For all of the foregoing reasons, claims 26, 28-30, 33, 43, and 45 are not taught or suggested by JP 6-70740 in view of Applicant's Admitted Prior Art, and the Examiner is respectfully requested to withdraw the rejection.

Applicant has cancelled claim 44 without prejudice to, or disclaimer of, the subject matter therein. In order to advance prosecution of this application, Applicant has not separately set forth arguments for the patentability of claim 44 over the references cited. Nonetheless, Applicant contends that this claim is patentable over JP 6-70740.

**Claim 27 - 35 U.S.C. § 103(a)**

The rejection of claim 27 under 35 USC 103(a) as being unpatentable over JP 6-70740 in view of Windesheim is respectfully traversed.

Windesheim relates to a pocket ash receptacle and extinguishing device.

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<sup>4</sup> See Spec., p. 2.

Claim 27 depends from claim 26. Applicant has previously set forth why claim 26 is patentable over JP 6-70740. The Examiner cites Windesheim as disclosing "an extinguishing device (10) which has an elliptically-shaped opening through which cigarettes are received to be snuffed . . . ."<sup>5</sup> However, Windesheim fails to otherwise cure the deficiencies of JP 6-70740 set forth above. Therefore, Applicant respectfully submits that claim 26 is patentable over JP 6-70740 in view of Windesheim. As claim 27 depends from claim 26, Applicant likewise respectfully submits that claim 27 is also patentable.

**Claims 31-32 - 35 U.S.C. § 103(a)**

The rejection of claims 31-32 under 35 USC 103(a) as being unpatentable over JP 6-70740 in view of Gilbert is respectfully traversed.

Gilbert relates to a cigarette snuffer that can be "incorporated in a variety of applications such as an ashtray, or with a pocket clip so that it can be inserted either into a pocket, or a cigarette package or the like."<sup>6</sup>

Claims 31 and 32 depend from claim 26. Applicant has previously set forth why claim 26 is patentable over JP 6-70740. The Examiner cites Gilbert as disclosing "a cigarette snuffer, which can be fabricated from plastic or metal . . . ."<sup>7</sup> However, Gilbert fails to otherwise cure the deficiencies of JP 6-70740 set forth above. For example, Gilbert does not teach or suggest cigarette savers having cross-sectional areas as recited in Applicant's claims. Further, Gilbert makes no reference to the size of a cigarette package, the number of

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<sup>5</sup> Office Action, mailed, May 21, 2003, p. 3.

<sup>6</sup> Gilbert, col. 1, ll. 54-57.

<sup>7</sup> Office Action, mailed May 21, 2003, p. 3.

cigarettes in a package, or how the cigarette snuffer might be arranged with the cigarettes in a package. The only reference in Gilbert to cigarette packages is the statement that it can be inserted into a cigarette package using a pocket clip.<sup>8</sup> *See id.* A cigarette snuffer having a pocket clip is illustrated in Fig. 5 of Gilbert and has a cross-sectional area that does not appear to be much larger than that of a single cigarette and is clearly not as large as the cross-sectional areas recited in the claims of the present invention.

Thus, Applicant respectfully submits that claim 26 is patentable over JP 6-70740 in view of Gilbert. As claims 31 and 32 depend from claim 26, Applicant likewise respectfully submits that claims 31 and 32 are also patentable.

**Claims 34, 36-38, 41-42, and 46 - 32 - 35 U.S.C. § 103(a)**

The rejection of claims 34, 36-38, 41-42, and 46 under 35 USC 103(a) as being unpatentable over JP 6-70740 in view of Applicant's Admitted Art, as applied in claim 26, further in view of JP 6-46822 is respectfully traversed.

JP 6-46822 relates to a cigarette package box usable as ash tray provided with extinguishing function. The purpose of the cigarette package box of JP 6-46822 is "to obtain a cigarette package box effective in preventing the throw-away of a cigarette end by providing a package box with a cigarette-holding part with partition plates and providing the extinguishing part with extinguishing tubes."<sup>9</sup> The cigarette package box includes a

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<sup>8</sup> See Gilbert, col. 1, ll. 54-57.

<sup>9</sup> JP 6-46822, Abstract.



cigarette-holding part that is divided with partition plates.<sup>10</sup> "Cigarettes 15 and cigarette butts extinguished in the extinguishing part 14 are separately held in each section of the cigarette holding part 13 separated by the partition plates 18."<sup>11</sup>

Applicant has amended claim 34 to clarify that a cigarette package comprises a paperboard crush proof box designed to hold twenty-three cigarettes; twenty cigarettes, each cigarette being in contact with at least one adjacent cigarette; and a rigid cigarette saver positioned inside the paperboard crush proof box and comprising two end portions, the distance between the two end portions forming a length of the cigarette saver. The first end portion includes an opening to a channel that terminates in the cigarette saver, the cigarette saver has a cross-sectional area that corresponds to the cross-sectional area of approximately three cigarettes.

Applicant has amended claim 46 to clarify that a cigarette package comprises a paperboard crush proof box designed to hold twenty-three cigarettes; twenty cigarettes, each cigarette being in contact with at least one adjacent cigarette; and a rigid cigarette saver positioned inside the paperboard crush proof box and comprising two end portions, the distance between the two end portions forming a length of the cigarette saver. The first end portion includes an opening to a channel that terminates in the cigarette saver, and the cigarette saver occupies a region corresponding to the volume of approximately three cigarettes.

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<sup>10</sup> *Id.*

<sup>11</sup> *Id.*

The Examiner notes that the rejected claims "differ from JP 6-70740 modified by Applicant's Admitted Art because of language that states the cigarette package is designed to hold twenty-three cigarettes . . . ." <sup>12</sup> The Examiner cites JP 6-46822 as disclosing a cigarette package having "a fire extinguishing section that corresponds to the cross-sectional area of three cigarettes . . . ." <sup>13</sup>

In connection with Applicant's traversal of the rejection of independent claims 26 and 45, Applicant pointed out certain deficiencies of JP 6-70740 in view of Applicant's Admitted Prior Art. At least some of these deficiencies are not cured by JP 6-46822.

For example, JP 6-46822 does not teach or suggest a paperboard crush proof box designed to hold twenty-three cigarettes as the cigarette package box of JP 6-46822 utilizes partition plates 18 for holding cigarettes and cigarette butts. The use of partition plates 18 would require a greater space than that required to house the cigarettes only. Thus, if the partition plates were arranged to hold twenty cigarettes, a space larger than that needed to hold the cigarettes only would be required.

In addition, amended claims 34 and 46 specify that each of the twenty cigarettes in Applicant's cigarette packages are in contact with at least one adjacent cigarette. In contrast, and as is the case with JP 6-70740, none of the cigarettes in JP 6-46822's cigarette package box are in contact with adjacent cigarettes due to the partition plates. Applicant respectfully submits that a person of ordinary skill in the art would not be motivated to construct the cigarette package box of JP 6-46822 without the housing part because the cigarette package

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<sup>12</sup> Office Action, mailed May 21, 2003, p 4.

<sup>13</sup> *Id.*

box is designed to hold cigarettes and cigarette butts in the cigarette-holding part. JP 6-46822 notes that: "Cigarettes 15 and cigarette butts extinguished in the extinguishing part 14 are *separately* held in each section of the cigarette holding part 13 separated by the partition plates 18."<sup>14</sup> Due to the difference in lengths between unsmoked cigarettes and cigarette butts, the partition plates would appear necessary to facilitate the insertion and removal of cigarettes and cigarette butts. Thus, Applicant also respectfully submits that JP 6-46822 lacks any suggest or motivation to not utilize partition plates.

For at least the reason that neither JP 6-70740, nor JP 6-46822, nor Applicant's Admitted Prior Art teach or suggest a cigarette package comprising a paperboard crush proof box designed to hold twenty-three cigarettes; twenty cigarettes, each cigarette being in contact with at least one adjacent cigarette; and a rigid cigarette saver positioned inside the paperboard crush proof box, Applicant respectfully submits that claims 34 and 46 are patentable. As claims 36-38 and 41-42 depend from claim 34, Applicant likewise respectfully submits that these claims are also patentable. For all of the foregoing reasons, claims 34, 36-38, 41-42, and 46 are not taught or suggested by JP 6-70740 in view of Applicant's Admitted Prior Art and further in view of JP 6-46822, and the Examiner is respectfully requested to withdraw the rejection.

**Claim 35 - 35 U.S.C. § 103(a)**

The rejection of claim 35 under 35 USC 103(a) as being unpatentable over

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<sup>14</sup> JP 6-46822 (emphasis added).

JP 6-70740 in view of Applicant's Admitted Prior Art and JP 6-46822, as applied to claim 34 above, and further in view of Windesheim is respectfully traversed.

Claim 35 depends from claim 34. Applicant has previously set forth why claim 34 is patentable over JP 6-70740 in view of Applicant's Admitted Prior Art and JP 6-46822. The Examiner cites Windesheim as disclosing "an extinguishing device (10) which has an elliptically-shaped opening through which cigarettes are received to be snuffed . . . ."<sup>15</sup> However, Windesheim fails to otherwise cure the deficiencies of JP 6-70740 in view of Applicant's Admitted Prior Art and JP 6-46822, as set forth above. Therefore, Applicant respectfully submits that claim 34 is patentable over JP 6-70740 in view of Applicant's Admitted Prior, JP 6-46822, and Windesheim. As claim 35 depends from claim 34, Applicant likewise respectfully submits that claim 35 is also patentable.

**Claims 39-40 - 35 U.S.C. § 103(a)**

The rejection of claims 39-40 under 35 USC 103(a) as being unpatentable over JP 6-70740 in view of Applicant's Admitted Art and JP 6-46822, and further in view of Gilbert is respectfully traversed.

Claims 39 and 40 depend from claim 34. Applicant has previously set forth why claim 34 is patentable over JP 6-70740 in view of Applicant's Admitted Art and JP 6-46822. The Examiner cites Gilbert as disclosing "a cigarette snuffer, which can be fabricated from plastic or metal . . . ."<sup>16</sup> However, Gilbert fails to otherwise cure the deficiencies of JP 6-

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<sup>15</sup> Office Action, mailed, May 21, 2003, p. 5.

<sup>16</sup> Office Action, mailed May 21, 2003, p. 3.

70740, Applicant's Admitted Art, and JP 6-46822, as set forth above. For example, Gilbert does not teach or suggest cigarette savers having cross-sectional areas as recited in Applicant's claims. Further, Gilbert makes no reference to the size of a cigarette package, the number of cigarettes in a package, or how the cigarette snuffer might be arranged with the cigarettes in a package. The only reference in Gilbert to cigarette packages is the statement that it can be inserted into a cigarette package using a pocket clip.<sup>17</sup> A cigarette snuffer having a pocket clip is illustrated in Fig. 5 of Gilbert and has a cross-sectional area that does not appear to be much larger than that of a single cigarette and is clearly not as large as the cross-sectional areas recited in the claims of the present invention.

Thus, Applicant respectfully submits that claim 34 is patentable over JP 6-70740 in view of Applicant's Admitted Art, JP 6-46822, and Gilbert. As claims 39 and 40 depend from claim 34, Applicant likewise respectfully submits that claims 39 and 40 are also patentable.

### **DEPENDENT CLAIMS**

In responding to the claim rejections above, Applicant submit that the dependent claims are patentable based on their dependency from independent claims, which Applicant argue are patentable. Thus, in many instances, Applicant has not provided separate remarks specifically directed to the Examiner's grounds for rejecting the dependent claims. Applicant's failure to comment on or otherwise traverse the Examiner's rejection of the

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<sup>17</sup> See Gilbert, col. 1, ll. 54-57.


dependent claims should not be viewed as agreement, on the part of the Applicant, with the Examiner's grounds for rejection.

**CONCLUSION**

For the foregoing reasons, a favorable Office Action is respectfully solicited. The Examiner is respectfully invited to contact J. Jason Link at 336.607.7443 or Charles W. Calkins at 336.607.7315 to discuss any matter relating to this application.

Respectfully submitted,

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